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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, N .W.
Washington, DC 20037-3213

EXAMINER	
ALLEN, WILLIAM J	

ART UNIT	PAPER NUMBER
3625	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/648,532	EMODI ET AL.	
	Examiner	Art Unit	
	William J. Allen	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 January 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28 and 57-81* is/are pending in the application.

4a) Of the above claim(s) *74-81* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,7-13,25,57-65 and 73* is/are rejected.

7)☒ Claim(s) *5-6, 14-24, 26-28, and 66-72* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Prosecution History Summary

Claims 1-28 and 57-81 are pending.

Claims 29-56 have been canceled.

Claims 74-81 are hereby withdrawn as set forth below.

Claims 1-4, 7-13, 25, 57-65, and 73 are rejected as set forth below.

Claims 5-6, 14-24, 26-28, and 66-72 are hereby indicated allowable as set forth below.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/17/2007 has been entered.

Allowable Subject Matter

Claims 5-6, 14-24, 26-28, and 66-72 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 1/17/2007 have been considered but are moot in view of the new ground(s) of rejection.

Election/Restrictions

Newly submitted claims 74-81 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Group I, Claims 1-28 and 59-73 and Group II, claims 74-81 are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, the subcombination of group II has separate utility such as wherein said menu includes an option to enter a telephone number corresponding to another device, to which said music track is forwarded and generating a menu containing criteria options relating to said music track so that the user makes a selection, said menu including an option to enter a telephone number corresponding to another device; and sending said music track to said another device. See MPEP § 806.05(d).

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 74-81 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 7, 59 and 62-63 are rejected under 35 U.S.C. 102(e) as being anticipated by Berman et al (US 6502194).

Regarding claim 1 and related claims 59 and 62, Berman teaches:

at least a first telephony platform which receives a command from a user's access device and generates a menu containing criteria options relating to at least one of a music track and a video track so that the user can make a selection (see at least: abstract lines 1-4, col. 3 lines 32-36, col. 4 lines 2-6, col. 6 line 64-col. 7 line 13, col. 7 line 26-28, Fig. 3); and

a first storage location coupled to said at least said first telephony platform, wherein said first storage location stores at least a part of said predetermined multimedia information, said predetermined multimedia information corresponding to said at least one of a music track and a video track (see at least: col. 4 lines 48-51, col. 5 lines 12-18, col. 7 lines 39-45); Note: Genre, artist, album, etc. represent multimedia information; and

wherein said first telephony platform has said predetermined multimedia information downloaded to an email address or a computer network address (see at least: col. 7 lines 55-63,

col. 8 lines 29-35, col. 13 lines 25-28 and 34-40, col. 15 lines 35-39). Note: media information is downloaded to the specific access device(playback unit) connected to the network.

Regarding claim 2, Berman teaches:

a *second storage location coupled to said at least first telephony platform*;

wherein said first storage location and said second storage location store at least said part of predetermined multimedia information;

wherein a first multimedia portion of said predetermined multimedia information is stored in said first storage location and a second multimedia portion of said predetermined multimedia information is stored in a second location (see at least: col. 7 lines 39-54, col. 13 lines 9-11);

where4in said at least first telephony platform selectively reproduces one of said first multimedia portion and said second multimedia portion as a selected multimedia portion based on said at least one multimedia command; and

wherein said at least first telephony platform outputs said selected multimedia portion to said access device (see at least: abstract, col. 7 lines 22-37, col. 8 lines 29-35, Fig. 3-4).

The Examiner notes that each file stored on the one or more audio material servers is stored in its own location on the server(s); thereby, the server(s) act to provide a first location, a second location, and so on. Each song (i.e. a first song of an album represents a first portion of the album, artist, etc., a second song a second portion, and so on) stored on the server(s) further has a specific URL or address, which represents the location of the specific song on the

server(s). In other words, a first song with a first address or URL represents a portion of the album, artist' work, etc. stored on the server.

Regarding claim 3, Berman teaches *wherein said predetermined multimedia information comprises at least one of music information and video information* (see at least: abstract, Fig. 3).

Regarding claim 4, Berman teaches *wherein said predetermined multimedia information comprises a first music track group, and wherein said first multimedia portion contains a first music track of said first music track group and said second multimedia portion contains a second music track of said first music track group* (see at least: col. 6 line 64-col. 7 line 1, col. 7 lines 22-28).

Regarding claim 7, Berman teaches *wherein said first music track group corresponds to an album, and wherein said first music track and said second music track correspond to music tracks on said album* (see at least: col. 6 line 64-col. 7 line 1, col. 7 lines 22-28).

Regarding claim 63, Berman teaches *where at least one command corresponds to at least one of an artist name, album, and type of music* (see at least: Fig. 3).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 8-13, 60-61, 64-65, and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berman in view of Chen (US 5991737).

Regarding claims 8 and related claims 11 and 64, Berman teaches all of the above as noted and further teaches user identification used for billing purposes and for personalization features (see at least: col. 13 lines 41-43). Berman, however, does not teach *wherein said at least one multimedia command comprises a purchasing command, and wherein said user can purchase said selected multimedia portion by inputting said purchasing command.* In the same field of endeavor, Chen teaches a system enabling consumers to respond to publicly broadcast information and purchase such information for personal use (see at least: abstract). More specifically, Chen teaches *wherein said at least one multimedia command comprises a purchasing command, and wherein said user can purchase said selected multimedia portion by inputting said purchasing command*(see at least: abstract, col. 1 lines 7-11, lines 15-18, and lines 36-44, col. 3 lines 23-31). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Berman to have included *wherein said at least one multimedia command comprises a purchasing command, and wherein said user can purchase said selected multimedia portion by inputting said purchasing command* as taught by

Chen in order to provide an improved system and method that enables consumers to respond to publicly broadcast information without having to identify the content of the information, and provide for automated purchasing of recordings of songs played over the radio when a consumer hears a song played over the radio that the consumer desires to purchase (see at least: Chen, col. 1 lines 1-18).

Regarding claims 9 and related claim 12, Berman in vie of Chen teaches *wherein said purchasing command instructs said at least said first telephony platform to have a copy of at least said selected multimedia portion mailed to a postal address of said user* (see at least: Chen, col. 5 lines 17-22).

Regarding claims 10 and related claims 13 and 65, Berman in view of Chen teaches *wherein said purchasing command instructs said at least said first telephony platform to have a copy of at least said selected multimedia portion downloaded to a computer network address of said user* (see at least: Berman, col. 7 lines 55-63, col. 8 lines 29-35, col. 13 lines 25-28 and 34-40, col. 15 lines 35-39).

Regarding claims 60-61 and related claim 73, these claims closely parallel the combinations above regarding claims 8-13 and are thereby rejected under the same rationale. In addition, the Examiner notes that Chen provides *a user initiated phone call* (see at least: col. 3 lines 22-31, col. 4 lines 61-col. 5 line 16).

5. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berman in view of Hughes et al. (US 20020023015).

Regarding claim 25, Berman teaches all of the above as noted and further teaches a display interface displaying song information (see at least: Fig. 2). Berman, however, does not expressly teach an *information command, wherein said telephony platform outputs an information message to said access device containing additional information relating to said selected multimedia portion.* In the same field of endeavor, Hughes teaches a system for purchasing digital content over an electronic network (see at least: abstract). More specifically, Hughes teaches *information command, wherein said telephony platform outputs an information message to said access device containing additional information relating to said selected multimedia portion* (see at least: 0036, Fig. 6b (#114), Fig. 6C (#123)). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Berman to have included *information command, wherein said telephony platform outputs an information message to said access device containing additional information relating to said selected multimedia portion* as taught by Hughes in order to allow users to drill down through indicia associated with artists, genres, or the like and easily obtain additional information concerning the desired purchasable content (see at least: Hughes, 0036).

6. Claims 57-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berman in view of Rosenberg (US 6879963).

Regarding claims 57-58, Berman teaches all of the above and further teaches means t converting a telephone signal into a message suitable for the telephony platform (see at least: col. 4 lines 2-6, col. 5 lines 14-18), *a means for generating control signals for the telephony platform* (see at least: col. 3 lines 64-66, Fig. 1-2, 14), and further including *a high-speed backbone that interconnects the various means* (see at least: col. 5 lines 14-18, Fig. 1, 14). Berman, however, does not expressly teach *a means for managing and a means for storing messages*. In the same field of endeavor, Rosenberg teaches enabling users to purchase and receive digital multimedia using various transmission mediums (see at least: abstract). More specifically, Rosenberg teaches *a means for managing and a means for storing messages* (see at least: abstract, col. 4 lines 31-39, Fig. 5). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Berman to have included *a means for managing and a means for storing messages* as taught by Rosenberg in order to provide a system enabling a consumer to first see (or listen) to the purchasable item before deciding whether to purchase it, further allowing consumers unable to initially view the broadcast to still purchase the items (see at least: Rosenberg, col. 3 lines 45-58).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US 20060190966 discloses systems and methods for providing a program as a gift using an interactive application
- US 20030009385 discloses an electronic messaging system and method thereof
- US 6286139 discloses an internet-based video ordering system and method

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Allen whose telephone number is (571) 272-1443. The examiner can normally be reached on 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William J. Allen
Patent Examiner
May 4, 2007

MATTHEW S. GART
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600